

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Mickey Roemer <i>et al.</i>	Examiner:	Pierce, William M
Application No.:	10/662,605	Group Art Unit:	3711
Filing Date:	September 15, 2003	Confirmation No.	2363
Office Action Date:	September 24, 2007	Docket No.	83336.0634
Title:	Method for Playing a Matching Game	Customer No.	66880

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

The following Appeal Brief is submitted pursuant to the Notice of Appeal dated October 4, 2007, for consideration by the Board. 37 C.F.R. § 41.37.

(i) ***REAL PARTY IN INTEREST***

The real party in interest is Bally Gaming, Inc.

(ii) ***RELATED APPEALS AND INTERFERENCES***

There are no prior or pending appeals, interferences, or judicial proceedings known to the appellant, the appellant's legal representative, or the assignee which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this pending appeal.

(iii) ***STATUS OF CLAIMS***

Claims 1-30 are canceled. Claims 62-97 are withdrawn. Claims 31-61 are pending, have been finally rejected, and are now being appealed.

(iv) ***STATUS OF AMENDMENTS***

No amendments have been filed subsequent to the final rejection mailed September 24, 2007.

(v) ***SUMMARY OF CLAIMED SUBJECT MATTER***

Independent Claim 31:

A method for playing a game (p. 8, ll. 13-15), the method comprising: displaying a plurality of indicia-bearing game pieces on a gaming grid (p. 8, ll. 23-26; p. 10, ll. 19-20; p. 14, ll. 22-23; FIG. 8, step 80; FIGS. 1, 3, and 8, elements 10, 12, 14, and 16; FIG. 8, step 80); receiving player input selecting game pieces that are adjacent to one another and that have matching indicia (p. 9, ll. 23-25; p. 10, ll. 24-26; p. 14, ll. 23-24; FIGS. 1 and 3, elements 12, 14, 17, and 34; FIG. 8, step 82); removing from the grid the matching adjacent game pieces that are selected (p. 8, ll. 28-29; p. 14, ll. 24-25); after all matching adjacent game pieces that are perceived by a player are selected and removed (p. 11, ll. 3-5 and 11-12; p. 14, ll. 26-28; FIG. 4, elements 14, 32, and 34; FIG. 8, step 84), shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces, the shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order (p. 11, ll. 5-10 and 12-24; p. 14, l. 28 – p. 15, l. 1; FIG. 4, elements 12, 14, 32, and 34; FIG. 8, step 86); and repeating the selection and removal of any matching adjacent game pieces (p. 10, ll. 28-30; p. 15, ll. 1-3 and 17-18; FIG. 8, steps 82, 85, and 86).

Independent Claim 60:

A method for playing a game that includes matching adjacent indicia (p. 8, ll. 13-15; p. 14, ll. 22-23), the method comprising: displaying a plurality of indicia-bearing game pieces on a gaming grid (p. 8, ll. 23-26; p. 10, ll. 19-20; p. 14, ll. 22-23; FIG. 8, step 80; FIGS. 1, 3, and 8, elements 10, 12, 14, and 16; FIG. 8, step 80); receiving player input selecting game pieces that are adjacent and that have matching indicia (p. 9, ll. 23-25; p. 10, ll. 24-26; p. 14, ll. 23-24; FIGS. 1 and 3, elements 12, 14, 17, and 34; FIG. 8, step 82); deactivating the matching adjacent game pieces that are selected by a player, wherein the deactivated cards cannot be selected again

(p. 10, ll. 15-17); shuffling only any non-deactivated game pieces; presenting the non-deactivated game pieces in a new random order (p. 10, ll. 15-17; p. 11, ll. 5-10 and 12-24; p. 14, l. 28 – p. 15, l. 1; FIG. 4, elements 12, 14, 32, and 34; FIG. 8, step 86); and awarding at least one prize associated with the selection and deactivation of the matching adjacent game pieces (p. 8, l. 29 – p. 9, l. 1; p. 14, ll. 24-26; FIG. 8, steps 84 and 88).

Independent Claim 61:

A method for playing a game (p. 8, ll. 13-15), the method comprising: displaying a plurality of indicia-bearing game pieces on a gaming grid (p. 8, ll. 23-26; p. 10, ll. 19-20; p. 14, ll. 22-23; FIG. 8, step 80; FIGS. 1, 3, and 8, elements 10, 12, 14, and 16; FIG. 8, step 80), wherein each game piece displays three different types of indicia (p. 13, ll. 25-27; FIG. 7, elements 12 and 16); receiving player input selecting game pieces that are adjacent to one another and that have at least one matching type of indicia (p. 9, ll. 23-25; p. 10, ll. 24-26; p. 14, ll. 23-24; FIGS. 1 and 3, elements 12, 14 and 17, and 34; FIG. 8, step 82); removing from the grid the matching adjacent game pieces that are selected (p. 8, ll. 28-29; p. 14, ll. 24-25); after all matching adjacent game pieces that are perceived by a player are selected and removed (p. 11, ll. 3-5 and 11-12; p. 14, ll. 26-28; FIG. 4, elements 14, 32, and 34; FIG. 8, step 84), shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces, the shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order (p. 11, ll. 5-10 and 12-24; p. 14, l. 28 – p. 15, l. 1; FIG. 4, elements 12, 14, 32, and 34; FIG. 8, step 86); and repeating the selection and removal of any matching adjacent game pieces (p. 10, ll. 28-30; p. 15, ll. 1-3 and 17-18; FIG. 8, steps 82, 85, and 86); and awarding at least one prize associated with the selection and removal of the matching adjacent game pieces (p. 8, l. 29 – p. 9, l. 1; p. 14, ll. 24-26; FIG. 8, steps 84 and 88).

(vi) ***GROUND OF REJECTION TO BE REVIEWED ON APPEAL***

Claims 31-61 were rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement.

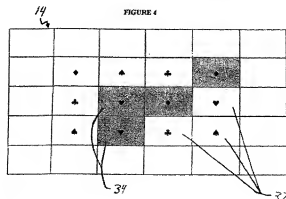
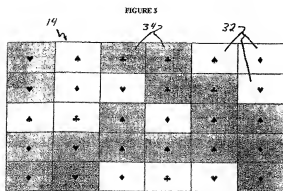
Claims 31-61 were rejected under 35 U.S.C. § 103(a) over the Monte Carlo publication in view of Kelly, U.S. Pat. No. 5,882,258, and further in view of the Same Game publication.

(vii) ***ARGUMENT***

Claims 31-61 comply with the 35 U.S.C. § 112 ¶ 1 written description requirement:

The Examiner asserted that “it is not considered from the application as filed that the [Appellants] intended ‘shuffling’ to include ‘a new random order’ as now is being claimed.” (Office action, p. 2, ll. 14-16). The Examiner further asserted that “[t]he only mention [of] ‘random’ is on p. 12, l. 13.” The Appellants respectfully disagree and request that the rejection be overturned.

At least one embodiment supporting the claimed “shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order” is disclosed in the Specification at p. 10, l. 18 – p. 11, l. 24. Briefly stated, the “non-selected game pieces 32” of FIG. 3 (see below) having a particular order are shuffled and then presented in the “new random order” of FIG. 4 (see below).



Initially, as shown in FIG. 3, the non-selected pieces 32 have an order of spade, spade, diamond, diamond, heart, heart, spade, club, diamond, diamond, club, heart (left to right, top row first). Subsequently, as shown in FIG. 4, the order of the shuffled and presented remaining pieces is diamond, spade, club, diamond, club, heart, diamond, heart, spade, heart, club, spade—a new random order.

The ordinary meaning of the term “shuffle” includes “a new random order.” M.P.E.P. § 2111.01 ¶ I provides that the words of a claim must be given their plain meaning unless such meaning is inconsistent with the specification. Additionally, M.P.E.P. § 2111.01 ¶ III provides that “plain meaning” refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.” However, as in this case, the ordinary meaning of the term “shuffle” is readily apparent. Thus, claim construction is best accomplished by relying on general purpose dictionaries.

Shuffle, interpreted broadly, is defined as (a) “manipulate (as a group of playing cards or tiles) with the real or ostensible purpose of causing a later appearance in random order (as in dealing or drawing)” or (b) “to push or move about, back and forth, or from one place to another.” Based on the Office action mailed February 12, 2007, the Appellants appreciated the breadth of the term “shuffle.” As such, the Appellants amended the claims on July 11, 2007 to clarify the claimed “shuffle,” commensurate with the disclosed embodiments, to definition (a) of the ordinary and customary meaning of “shuffle.” In turn, the claimed “shuffling” should be construed as causing the remaining game pieces to be in a “new random order.” Therefore, the Appellants respectfully submit that the Appellants both had possession of and disclosed the claimed invention including the “new random order” claim element at the time of filing the present application.

**Claims 31-61 are non-obvious over the Monte Carlo publication in view of Kelly,
U.S. Pat. No. 5,822,258, and further in view of the Same Game publication:**

The Examiner rejected claims 31-61 under 35 U.S.C. § 103(a) as being unpatentable over the Monte Carlo publication in view of Kelly, and further in view of the Same Game publication. The Appellants respectfully request that the rejection be overturned.

Independent claim 31 recites the following elements that are non-obvious in view of the references of record:

shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces,

the shuffling causing the remaining game pieces to be in a new random order, and

the new grouping of the remaining pieces being in the new random order.

(Emphasis added). The Examiner asserted that the “shuffling causing the remaining game pieces to be in a new random order” claim element is disclosed by the Monte Carlo reference. More specifically, the Examiner asserted that Monte Carlo discloses that cards are moved up to fill in the spaces of removed cards (Office action, p. 3. ll. 5-7). However, Monte Carlo only discloses aligning the remaining game pieces to eliminate empty spaces. Monte Carlo does not disclose causing the remaining game pieces to have a new random order.

The claimed “new random order” distinguishes over Monte Carlo’s “same” order. The Examiner’s reliance on Monte Carlo and Jawbreaker for “shuffling” appears to be based on the second shuffle definition, (b) “to push or move about, back and forth, or from one place to another.” In other words, the shuffling of Monte Carlo and Jawbreaker causes the remaining game pieces to remain in the same order as prior to the shuffle. By contrast, the claimed shuffling is limited to the first shuffle definition, (a) causing the claimed remaining game pieces to be in a “new random order.” Dispositive to this appeal, “same” is fundamentally different from “random.” Nothing in Kelly or Same Game overcomes Monte Carlo’s shortcoming, *i.e.*, the lack of disclosing a new random order of the remaining pieces.

Moreover, the Appellants respectfully submit that Monte Carlo's teaching to consolidate a plurality of game pieces while keeping the pieces in a fixed order teaches away from causing the remaining pieces to be in a new random order. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." See also M.P.E.P. § 2144.05 entitled, Rebuttal Of Prima Facie Case Of Obviousness (stating that "a prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention"). Therefore, the Appellants respectfully submit that claim 31 is non-obvious over Monte Carlo in view of Kelly, and further in view of Same Game.

The Appellants respectfully submit that claims 32-59 are non-obvious over Monte Carlo in view of Kelly, and further in view of Same Game at least by virtue of their dependence from claim 31. The Appellants note that claims 32-59 depend from independent claim 31. For the sake of brevity, the rejection of claim 31 is discussed in detail on the understanding that claims 32-59 are also patentably distinct over the prior art, as they depend directly from claim 31. Nevertheless, claims 32-59 include additional features that, in combination with those of claim 31, provide further, separate and independent bases for patentability.

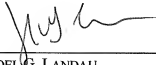
In like manner, the Appellants respectfully submit that independent claims 60 and 61 are non-obvious over Monte Carlo in view of Kelly, and further in view of Same Game for the same reasons as set forth with regard to claim 31.

CONCLUSION

In conclusion, the Appellants respectfully submit that the 35 U.S.C. §§ 112 ¶ 1 and 103(a) rejection of claims 31-61 be overturn and allowed to issue. The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name Steptoe & Johnson LLP.

Respectfully submitted,

Date: December 4, 2007



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(viii) CLAIMS APPENDIX

The claims involved in this Appeal are as follows:

31. A method for playing a game, the method comprising:
displaying a plurality of indicia-bearing game pieces on a gaming grid;
receiving player input selecting game pieces that are adjacent to one another and that have matching indicia;
removing from the grid the matching adjacent game pieces that are selected;
after all matching adjacent game pieces that are perceived by a player are selected and removed, shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces, the shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order; and
repeating the selection and removal of any matching adjacent game pieces.
32. The method of claim 31, wherein the selection of game pieces that are adjacent and have matching indicia, and the removal of any matching adjacent game pieces that are selected, proceeds one pair of matching adjacent game pieces at a time.
33. The method of claim 31, wherein the selection of game pieces that are adjacent and have matching indicia, and the removal of any matching adjacent game pieces that are selected, proceeds until all matching adjacent game pieces that are perceived by a player have been removed, and the prizes associated therewith have been awarded.
34. The method of claim 31, wherein adjacent game pieces are defined as game pieces that touch along a vertical edge, a horizontal edge, or a diagonal corner.
35. The method of claim 31, wherein each game piece contains only a single indicium that is used to potentially match with the indicia displayed on adjacent game pieces.
36. The method of claim 35, wherein the indicium displayed on each game piece that is used to match with the indicia of adjacent game pieces corresponds to the prize to be awarded.
37. The method of claim 31, wherein the prize to be awarded is a non-monetary prize.

38. The method of claim 37, wherein the prize to be awarded is a displayed magazine photograph.
39. The method of claim 38, wherein the prize to be awarded is a displayed magazine cover.
40. The method of claim 31, wherein each game piece contains a plurality of indicia that are used to potentially match with at least one of the plurality of indicia of the adjacent game pieces.
41. The method of claim 40, wherein each game piece contains three indicia that are used to potentially match with at least one of the three indicia of the adjacent game pieces.
42. The method of claim 41, wherein three indicia of the game pieces include game piece color, type of indicia, and color of indicia.
43. The method of claim 31, wherein the game pieces are selected using touch screen technology.
44. The method of claim 31, wherein the game pieces are video representations of game pieces.
45. The method of claim 31, wherein the game pieces are tiles.
46. The method of claim 30, wherein method for playing a game incorporates the use of selection buttons.
47. The method of claim 31, wherein the shuffling of any remaining game pieces and the selecting of matching adjacent game pieces is repeatable a predetermined number of times.
48. The method of claim 47, wherein the shuffling of any remaining game pieces and selecting of matching adjacent game pieces is repeatable up to three times.
49. The method of claim 31, wherein one or more prizes are awarded in connection with the total number of matches made of adjacent game pieces.

50. The method of claim 31, wherein one or more prizes are awarded in connection with indicia shown on games pieces that are matched.

51. The method of claim 31, wherein one or more prizes are awarded in connection with indicia shown on games pieces that are matched last.

52. The method of claim 31, wherein one or more prizes are awarded in connection with indicia shown on games pieces that are not matched.

53. The method of claim 31, wherein one or more prizes are awarded in connection with the speed with which the game pieces are matched.

54. The method of claim 31, wherein one or more prizes are awarded in connection with the number of shuffles required to match all the game pieces.

55. The method of claim 31, wherein one or more prizes are awarded in connection with the matching of all game pieces.

56. The method of claim 31, wherein one or more prizes are awarded in connection with player status.

57. The method of claim 31, wherein the method for playing a game is at least partially skill based.

58. The method of claim 31, wherein the method for playing a game has the appearance of being at least partially skill based.

59. The method of claim 31, further comprising:

in response to a selection event by a player, activating an interactive help feature for a bonus game during play of the bonus game, wherein the help feature is available on demand by the player, and wherein the help feature is initiatable at any time during play of the bonus game so that a player may receive instructions that assist in proper play of the bonus game while the bonus game is in active use; and

resuming play of the bonus game after the use of the help feature is completed.

60. A method for playing a game that includes matching adjacent indicia, the method comprising:

- displaying a plurality of indicia-bearing game pieces on a gaming grid;
- receiving player input selecting game pieces that are adjacent and that have matching indicia;
- deactivating the matching adjacent game pieces that are selected by a player, wherein the deactivated cards cannot be selected again;
- shuffling only any non-deactivated game pieces;
- presenting the non-deactivated game pieces in a new random order; and
- awarding at least one prize associated with the selection and deactivation of the matching adjacent game pieces.

61. A method for playing a game, the method comprising:

- displaying a plurality of indicia-bearing game pieces on a gaming grid, wherein each game piece displays three different types of indicia;
- receiving player input selecting game pieces that are adjacent to one another and that have at least one matching type of indicia;
- removing from the grid the matching adjacent game pieces that are selected;
- after all matching adjacent game pieces that are perceived by a player are selected and removed, shuffling any remaining game pieces and presenting a new grouping of the remaining game pieces, the shuffling causing the remaining game pieces to be in a new random order, and the new grouping of the remaining pieces being in the new random order;
- repeating the selection and removal of matching adjacent game pieces; and
- awarding at least one prize associated with the selection and removal of the matching adjacent game pieces.

(ix) EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title. No other evidence has been entered by the examiner and relied upon by Appellants in the appeal.

(x) RELATED PROCEEDINGS APPENDIX

As there are no prior or pending appeals, interferences, or judicial proceedings known to the appellant, the appellant's legal representative, or the assignee which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this pending appeal (pursuant to 37 C.F.R. § 41.37(c)(1)(ii)), there are no decisions rendered by a court or the Board in any proceedings to include herein.